



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,022	11/27/2001	Steven O. Markel	INTE.26USU1 (ITC42)	6138
43997	7590	03/07/2006	EXAMINER	
OPTV/MOFO C/O MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD, SUITE 300 MCLEAN, VA 22102			JOHNSON, ALAN M	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,022

Applicant(s)

MARKEL, STEVEN O.

Examiner

Alan M. Johnson

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/29/03 2/2/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Specification

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5, 6, 17, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (6,698,020).

In regards to claim 1 Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising:

presenting a streaming video program (video programming feed) in a video presentation window (58 Fig. 7 and 58 Fig. 8 and column 7 lines 23-25);

receiving an ad event signal (advertisements included in the video programming feed, column 7 lines 13-15);

pausing presentation of the streaming video program in response to the ad event signal (when the advertisement insertion device interrupts the video signal, the

Art Unit: 2611

video signal is paused until the advertisement has been displayed in its entirety column 7 lines 26-32 and column 16 lines 35-45);

opening a display window (when the advertisement signal interrupts the display of the video programming feed, the video display inherently opens up a new window in which to display the advertisement column 7 lines 26-32 and column 16 lines 30-43);

displaying advertising in the display window (column 7 lines 26-32);

closing the display window (once the advertisement has been displayed in its entirety, the display device inherently closes the window and reopens the window displaying the program feed column 16 lines 35-41);

resuming presentation of the streaming video program (column 16 lines 35-41).

Dealing with claim 5 Zigmond discloses the ad even signal that is embedded in the streaming video program (column 7 lines 13-15).

As for claim 6, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable

Art Unit: 2611

media having computer executable instructions column 6 lines 48-50 and software is included in the ad insertion device line 26-36).

As for claim 17, Zigmond discloses a method for displaying advertising comprising:

presenting a streaming video program in a video presentation window (58 Fig. 7 and 58 Fig. 8 and column 7 lines 23-25);

receiving an ad event signal (advertisements included in the video programming feed, column 7 lines 13-15);

pausing presentation of the streaming video program in response to the ad event signal (when the advertisement insertion device interrupts the video signal, the video signal is paused until the advertisement has been displayed in its entirety column 7 lines 26-32 and column 16 lines 35-45);

selecting a display window other than the video presentation window in response to the ad event signal (when the advertisement signal interrupts the display of the video programming feed, the video display inherently opens up a new window in which to display the advertisement column 7 lines 26-32 and column 16 lines 30-43);

Art Unit: 2611

saving the contents of the display window (the paused video program is inherently saved since it is opened back up to its pre-advertisement position once the advertisement has been displayed in its entirety, column 7 lines 26-32 and column 16 lines 35-45);

displaying advertising in the display window in response to the ad event signal (column 7 lines 26-32);

restoring the contents of the display window (the paused video program is inherently restored since once the advertisement has been displayed, the video presentation window opens back up at the position in which it was last at before the advertisement was displayed, column 7 lines 26-32 and column 16 lines 35-45);

resuming presentation of the streaming video program (column 16 lines 35-41).

Dealing with claim 23, Zigmond discloses a method for displaying advertising comprising:

presenting a first streaming video program in a video presentation window (58 Fig. 7 and 58 Fig. 8 and column 7 lines 23-25);

Art Unit: 2611

receiving an ad event signal (advertisements included in the video programming feed, column 7 lines 13-15).

displaying a first advertisement associated with the first streaming video program in a display window in response to the ad event signal (column 7 lines 26-32);

receiving a second streaming video program (the program feed will include a first and any other subsequent streaming video programs, column 7 lines 23-25);

setting an indicator if an advertisement is being presented in conjunction with the second streaming video program (the advertisement inserting device inserts advertisements in the programming feed and depending on a time specified by encoded, the advertisement will be displayed which shows that there is an indicator set whenever an advertisement is sent to the insertion device which indicates when the ad is to be displayed, column 7 lines 26-30).

displaying a second advertisement associated with the second streaming video program in the display window if the indicator is set (column 7 lines 26-30).

Art Unit: 2611

presenting the second streaming video program in the video presentation window (the system displays a first and any subsequent streaming video program column 7 lines 23-25).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Swix (6,609,253).

With respect to claim 2, Zigmond fails to specifically teach disabling at least one control function of the display window.

However, in an analogous art Swix discloses disabling at least one control function of the display window (column 13 lines 57-60).

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include disabling at least one control function of the display window, as taught by Swix, for the benefit of preventing users from fast-forwarding through commercials.

As for claim 7, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising:

presenting a streaming video program in a video presentation window (58 Fig. and 58 Fig. 8 and column 7 lines 23-25);

receiving an ad event signal (advertisements included in the video programming feed, column 7 lines 13-15);

pausing presentation of the streaming video program in response to the ad event signal (when the advertisement insertion device interrupts the video signal, the video signal is paused until the advertisement has been displayed in its entirety column 7 lines 26-32 and column 16 lines 35-45);

displaying advertising in the video presentation window in response to the ad event signal (column 7 lines 26-32);

resuming presentation of the streaming video program (column 16 lines 35-41);

Art Unit: 2611

Zigmond fails to specifically teach a method for displaying advertising comprising:

disabling at least one control function of the video presentation window in response to the ad event signal;

re-enabling the at least one control function of the presentation window;

In an analogous art, Swix discloses a method for displaying advertising comprising:

disabling at least one control function of the video presentation window in response to the ad event signal (column 13 lines 57-59);

re-enabling the at least one control function of the presentation window (the disabling of the buttons only lasts for the duration of the advertisement, once the advertisement ends, the fast forward button will be re-enabled column 13 lines 57-59);

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include disabling at least one control function of the video presentation window in response to the ad event signal and re-enabling the at least one control function of the presentation window, as taught by Swix, for the benefit of taking control

away from the user for the duration of an advertisement so that the user cannot fast-forward or skip past the advertisement being displayed.

Dealing with claim 10, Zigmond and Swix disclose the ad signal that is embedded in the streaming video program (Zigmond, column 7 lines 13-15).

As for claim 11, Zigmond and Swix disclose the ad event signal that is generated by a software program operating at the receiver of the streaming video program (Zigmond, the system includes computer-readable media having computer executable instructions column 6 lines 48-50 and software is inherently included in the ad insertion device line 26-36).

5. Claims 3 and 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Shoff (US2005/0015815A1).

Dealing with claim 3, Zigmond fails to specifically teach adjusting the display window to a predetermined size.

However, in an analogous art Shoff teaches adjusting the display window to a predetermined size (the display layout information is contained within the digital data that is sent with the program signal, paragraph 69, 70 and 71).

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include adjusting the display window to a predetermined size, as taught by Shoff, for the benefit of ensuring that the advertisement window is large enough for the viewer to see the contents of the advertisement window.

With respect to claim 4, Zigmond fails to specifically teach adjusting the display window to full-screen size.

However in an analogous art, Shoff teaches adjusting the display window to full-screen size (the display layout defines any layout including full screen paragraph 69 and the program boundary paragraph 71)

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include adjusting the display window to full-screen size, as taught by Shoff, for the benefit of ensuring the users attention to the display can only be directed towards the advertisement.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Swix as applied to claim 7 above, and further in view of Shoff.

With respect to claim 8, Zigmond and Swix disclose all the limitations of claim 7 but fail to specifically disclose adjusting the video presentation window to a predetermined size.

However, in an analogous art, Shoff teaches adjusting the video presentation window to a predetermined size (the display layout information is contained within the digital data that is sent with the program signal, paragraph 69, 70 and 71).

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's and Swix's system to include adjusting the video presentation window to a predetermined size, as taught by Shoff, for the benefit of ensuring that the advertisement window is large enough for the viewer to see the contents of the advertisement window.

Dealing with claim 9, Zigmond and Swix disclose all the limitations of claim 7 but fail to specifically disclose adjusting the video presentation window to full-screen size.

In an analogous art, Shoff discloses adjusting the video presentation window to full-screen size (the display layout defines any layout including full screen paragraph 69 and the program boundary paragraph 71)

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's and Swix's system to include adjusting the display window to full-screen size, as taught by Shoff, for the benefit of ensuring that the users attention to the display can only be directed towards the advertisement.

7. Claims 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Cunningham (US2005/0080878A1).

In regards to claim 12, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising:

presenting a streaming video program (video programming feed) in a video presentation window (58 Fig. 7, 58 Fig. 8 and column 7 lines 23-25);

receiving an ad event signal (column 7 lines 13-15);

continuing presentation of the streaming video program (that advertisement is not displayed immediately upon reception of the ad signal, the advertisement insertion device interrupts the programming feed at an appropriate time specified by encoded data column 7 lines 23-29);

Art Unit: 2611

Continuing the presentation of the streaming video program (column 16 lines 35-41);

However, Zigmond fails to specifically teach:

checking the size of the video presentation window in response to the ad event signal;

adjusting the size of the video presentation window to a predetermined size if the window is of another size;

overlaying the streaming video program with an advertisement in response to the ad event signal;

restoring the size of the video presentation window if the size was adjusted;

In an analogous art, Cunningham discloses:

checking the size of the video presentation window in response to the ad event signal (Cunningham's system does not permit the user to reduce the size of the viewer display window beyond a minimum size in order to ensure the advertisements have a minimum display area for their ads, paragraph 73);

adjusting the size of the video presentation window to a predetermined size if the window is of another size (if the user attempts to adjust the size of the viewer display window to a size that is smaller than the minimum predetermined size, the window will inherently be sized to the minimum predetermined size paragraph 73);

overlaying the streaming video program with an advertisement in response to the ad event signal (paragraph 56);

restoring the size of the video presentation window if the size was adjusted (if the user attempts to adjust the size of the viewer display window to a size that is smaller than the minimum predetermined size, the window will inherently be restored to the minimum predetermined size paragraph 73);

It would have been obvious to one of ordinary skill in the art to modify Zigmond's system to include checking the size of the video presentation window in response to the ad event signal, adjusting the size of the video presentation window to a predetermined size if the window is of another size, overlaying the streaming video program with an advertisement in response to the ad event signal and restoring the size of the video presentation window if the size was adjusted, as taught by Cunningham, for the benefit of ensuring that the size of

Art Unit: 2611

the display was larger than the minimum predetermined size in order to insure that the displayed advertisement was seen by the viewer.

Dealing with claim 13, Zigmond and Cunningham disclose the ad signal that is embedded in the streaming video program (Zigmond, column 7 lines 13-15).

As for claim 14, Zigmond and Cunningham disclose the ad event signal that is generated by a software program operating at the receiver of the streaming video program (Zigmond, software included in the ad insertion device line 26-36).

8. Claims 15, 16, 18, 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Cunningham as applied to claim 12 above, and further in view of Swix.

With respect to claim 15, Zigmond and Cunningham disclose all the limitations of claim 12 but fail to specifically disclose disabling at least one control function of the video presentation window.

However, in an analogous art, Swix teaches disabling at least one control function of the video presentation window (column 13 lines 57-59);

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's and Cunningham's system to include disabling at least one control function of the video presentation window, as taught by Swix, for the benefit of taking control away from the user for the duration of an advertisement so that the user cannot fast-forward or skip past the advertisement being displayed.

In regards to claim 16, Zigmond and Cunningham disclose all the limitations of claim 12 but fail to specifically disclose re-enabling the at least one control function of the video presentation window.

However, in an analogous art, Swix teaches re-enabling the at least one control function of the video presentation window (the disabling of the buttons only lasts for the duration of the advertisement, once the advertisement ends, the fast forward button will be re-enabled column 13 lines 57-59);

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's and Cunningham's system to include re-enabling the at least one control function of the presentation window, as taught by Swix, for the benefit of taking control away from the user for the duration of an advertisement so that the user cannot fast-forward or skip past the advertisement being displayed.

Art Unit: 2611

With respect to claim 18, Zigmond and Cunningham disclose all the limitations of claim 12 but fail to specifically teach disabling at least one control function of the display window.

In an analogous art, Swix discloses disabling at least one control function of the display window (column 13 lines 57-59).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Zigmond and Cunningham to include disabling at least one control function of the video presentation window in response to the ad event signal, as taught by Swix, for the benefit of taking control away from the user for the duration of an advertisement so that the user cannot fast-forward or skip past the advertisement being displayed.

In regards to claim 19, Zigmond and Cunningham fail to specifically teach re-enabling the at least one control function of the display window

In an analogous art, Swix discloses re-enabling the at least one control function of the display window (the disabling of the buttons only lasts for the duration of the advertisement, once the advertisement ends, the fast forward button will be re-enabled column 13 lines 57-59);

It would have been obvious to one of ordinary skill in the art to modify the combined system of Zigmond and Cunningham to include re-enabling the at least one control function of the presentation window, as taught by Swix, for the benefit of returning full control to the user as soon as the advertisement has been displayed in its entirety.

9. Claims 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Cunningham as applied to claim 12 above, and further in view of Shoff.

In regards to claim 20, Zigmond and Cunningham disclose all the limitations of claim 12 but fail to specifically teach adjusting the size of the display window.

In an analogous art, Shoff discloses adjusting the size of the display window (the display layout information is contained within the digital data that is sent with the program signal, paragraph 69, 70 and 71).

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's and Cunningham's system to include adjusting the size of the display window, as taught by Shoff, for the benefit of ensuring that the advertisement window is large enough for the viewer to see the contents of the advertisement window.

Art Unit: 2611

10. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Cunningham as applied to claim 12 above, and further in view of Swix as applied to claim 15 in further view of Shoff

Dealing with claim 21, Zigmond, Cunningham and Swix disclose all the limitations of claim 15 but fail to specifically teach adjusting the display window to a predetermined size.

In an analogous art, Shoff discloses adjusting the display window to a predetermined size (the display layout information is contained within the digital data that is sent with the program signal, paragraph 69, 70 and 71).

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's Cunningham's and Swix's system to include adjusting the size of the display window, as taught by Shoff, for the benefit of ensuring that the advertisement window is large enough for the viewer to see the contents of the advertisement window.

As for claim 22, Zigmond, Cunningham and Swix disclose all the limitations of claim 15 but fail to specifically disclose adjusting the display window to full-screen size.

Art Unit: 2611

In an analogous art, Shoff teaches adjusting the display window to full-screen size (the display layout defines any layout including full screen paragraph 69 and the program boundary paragraph 71).

It would have been obvious to one of ordinary skill in the art to modify the combination of Zigmond's, Cunningham's, and Swix's system to include adjusting the display window to full-screen size, as taught by Shoff, for the benefit of ensuring the users attention to the display can only be directed towards the advertisement.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan M. Johnson whose telephone number is (571)272-7916. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AJ



CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600